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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------------|------------------|
| 10/808,457 | 03/25/2004 | John Barry | 024445-463 | 4856 |
| 55694 | 7590 | 12/15/2005 | | |
| DRINKER BIDDLE & REATH (DC) 1500 K STREET, N.W. SUITE 1100 WASHINGTON, DC 20005-1209 | | | | |
| | | | EXAMINER BATES, ZAKIYA W | |
| | | | ART UNIT 3676 | PAPER NUMBER |

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/808,457 | BARRY, JOHN | |
| | Examiner | Art Unit | |
| | Zakiya W. Bates | 3676 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-8 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 3-5,9 and 13 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11052004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claims 8-10 are objected to because of the following informalities: claims 8 and 9 recite "said [the] projection structure," which lacks antecedent basis. Appropriate correction is required.
2. Claims 11-13 are objected to because of the following informalities: Claim 11 appears to set forth the terms "a rear end" and "a pair of parallel side walls" twice within the claim. See lines 2, 4, 11, and 12. It is unclear if the second set of terms could be distinguished from the first set. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 6-8, and 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,684,968.

US'968 discloses an apparatus that includes, with respect to claim 1, a drill bit assembly 10 including a drill bit having a leading end 14 to which a drill tip 32 is fixed by bonding, said drill tip having a front cutting edge, a pair of side cutting edges 44, 46, a

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rear end 28, and a pair of parallel side walls 42, said leading end being arranged to support said rear end and said parallel side walls of said drill tip, said drill bit including a bore extending axially therethrough (through 20) and opening into said leading end, said drill tip extending across said bore in a lateral direction and permitting egress of flushing liquid from said bore, said drill tip including a locating structure 51 arranged to engage an engagement face structure formed at said leading end of said drill bit to locate said drill tip in a prescribed bonding position relative to said leading end prior to bonding of said drill tip to said leading end, and to resist shifting movement of said drill tip in said lateral direction out of said prescribed bonding position during bonding of the drill tip.

With respect to the depending claims, the reference teaches the limitations as claimed.

With respect to claim 11, the reference discloses a drill tip 32 for a drill bit, comprising a front end having a pair of front cutting edges, a pair of side cutting edges 44, 46, a rear end 28 disposed opposite the front end and being elongated in a direction of elongation from one side cutting edge to the other side cutting edge, and a pair of parallel side walls 42 each interconnecting the front and rear ends, the tip defining a center axis of rotation extending through the front and rear ends in a direction perpendicular to the direction of elongation, the front cutting edges being inclined obliquely relative to the axis of rotation in a direction generally away from the rear end and being inclined obliquely relative to the axis of rotation in a direction generally away from the rear end and being inclined obliquely relative to the axis of rotation as viewed perpendicularly to the side walls, a rear end elongated in a direction of elongation, and a pair of parallel side walls, said rear end having a locating structure to locate said drill tip in a bonding

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position prior to being bonded to a drill bit, to resist shifting movement of said drill tip in said direction of elongation and out of the bonding position. With respect to claim 12, the locating structure is projection 51.

Allowable Subject Matter

5. Claims 3-5, 9, and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,184,925 teaches a bit with a drill tip having a projection structure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zakiya W. Bates whose telephone number is (571) 272-7039. The examiner can normally be reached on Monday-Friday, 8:30 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Zakiya W. Bates
Primary Examiner
Art Unit 3676

zb

December 8, 2005